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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/008,148	01/16/98	FRUITMAN C	29131.0217

QM11/0709

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EXAMINER	
MORGAN, E	
ART UNIT	**PAPER NUMBER**
3723	

DATE MAILED: 07/09/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/008,148	Applicant(s) Fruitman
	Examiner E. MORGAN	Group Art Unit 3723

☒ Responsive to communication(s) filed on *Jan 16, 1998*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *4-10* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *4-10* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *2,3*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 4-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-13,16-19,1,2 of U.S. Patent No. 5,769,691. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application is directed to planarizing a workpiece with a lapping surface and the patent claims planarizing a silicon wafer with a lapping pad. This is an obvious variation over the patented subject matter and the term "pad" would include a "soft and pliable material."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronay 5,752,875 in view of Samuelson-4,048,765.

5. Ronay discloses polishing a wafer with a pad and a slurry solution of silica and a hydroxide with the claimed size range and weight percentage. Ronay discloses a polyurethane pad to polish wafer but not specifically a non-cellular pad. However, Samuelson teaches polishing with a non-cellular pad of non-cellular urethane that is flexible and free to deform with workpiece. Therefore, it would have been obvious to one of ordinary at time invention was made to substitute the pad in Ronay with a non-cellular pad, as taught by Samuelson, in order to increase the heat distortion, decrease the friction, and prevent clogging and build-up, therefore, increasing pad life to 3-5 times that of other pads.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Morgan whose telephone number is (703) 308-1743.

7/1/98
EILEEN P. MORGAN
PRIMARY EXAMINER

EM

July 1, 1998